

Appl. No. 09/979,493
Atty. Docket No. 7611M
Amdt. dated 06 October, 2005
Reply to Office Action of 06 April, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1 - 37 are pending in the present application. No additional claims fee is believed to be due.

Rejections Under 35 USC §103(a)

Claims 1-5, 11, 15-22, and 27-33 have been rejected under 35 USC §103(a) as being unpatentable over the Family Tree House website in view of Adler et al (U.S. 6,675,356). Claims 6-10, 12-14, 23-26, and 34-37 have been rejected under 35 USC §103(a) as being unpatentable over the Family Tree House website in view of Adler et al (U.S. 6,675,356) in further view of Tuzhilin et al (U.S. 6,236,978). These rejections are hereby respectfully traversed as the combination of the Family Tree House website and Adler et al references, and the Family Tree House website, Adler et al and Tuzhilin et al references, do not establish a *prima facie* case of obviousness.

The Family Tree House website, as best as can be determined from the provided print-outs of the website, discloses a website that allows a registered user to input predefined and structured genealogical relationships, and then display and/or disseminate via user inputted e-mail addresses that same structured relationship graphically, using HTML code. The Adler et al reference discloses a system for managing, with user guidance and input, calendar information obtained from a variety of sources. The Tuzhilin et al reference discloses systems and methods for generating user profiles.

I. The cited reference combinations of Family Tree House website in view of Adler et al (U.S. 6,675,356) does not disclose each and every element of Applicant's presently claimed invention.

As is fundamental, a *prima facie* case of obviousness must be based on facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (C.C.P.A. 1970). When the rejection is not supported by facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (B.P.A.I. 1993). Moreover, as is clearly required by law, to establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or

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suggested by the prior art. MPEP 2143.03. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Office Action asserts that the Family Tree House web site teaches "a method assisted integrated family information management system" that comprises: a "central module containing at least one data file;" a "one family data file;" a "user interface system;" "at least one information source connected to said central control module;" and "relevant family information obtained from said information source." (*Office Action dated 06 April, 2005, Pages 2-3*). The Office Action acknowledges, however, that with respect to the reference combination of Family Tree House and Adler that the presently claimed invention differs from the cited reference(s) in that "the Family Tree House reference does not clearly disclose a 'module' or the specific structural system to carry out the disclosed system." (*Office Action dated 06 April, 2005, Page 3*). The Office Action further acknowledges that with respect to the reference combination of Family Tree House and Adler, that the presently claimed invention differs from the cited references in that the combination "does not clearly disclose that relevant information is obtained upon recognition of a predetermined event, a predetermined time interval, a predetermined time schedule." (*Id.*, Page 5.).

To fill the acknowledged gaps, the Office Action relies upon the assumption that "one of ordinary skill in the art would have recognized that some physical system must be implemented in the Family Tree House reference," and "it would have been obvious to one with ordinary skill in the art at the time the invention was made to implement Alder's system in carrying out the Family Tree House method." (*Id.*, Page 4). The Office Action then concludes that "it would have been obvious to install the Family Tree House software on the Adler system," (*Id.*), though it does not provide a motivation to do so, or any statutory prior art that such a combination would result in Applicants' presently claimed invention.

As can best be understood from the web pages provided by the Examiner the Family Tree House website simply allows a registered user to input predefined and structured genealogical relationships, and then display and/or disseminate via user inputted e-mail addresses that same structured relationship graphically, using HTML

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code. In contrast, Applicant's present invention is directed towards a family information management system that provides a computer assisted method for enabling family members to continuously maintain contact, while also receiving helpful and necessary information regarding a family's daily activities (Specification, Page 9, Line 18 – Page 10, Line 1). Value-added family information is developed in Applicant's present invention by the central control module from multiple information sources that are connected and/or integrated to the central control module (Specification, Page 8, Lines 16-21).

In further contrast, the Family Tree House site only contains limited information on specific familial relationships (e.g., names and dates of birth/death of parents and children), and does not contain any information at all on a family's daily activities, preferences, or schedules. Moreover, as best as can be determined, the Family Tree House application does not have any access to any information sources other than user inputted familial relationship that may be used to develop and communicate value added family information in the manner of the present invention. The Examiner states that Pages 10-12 of the office action dated 26 August, 2004 provides suitable examples of information sources connected to the central control module. However, the Applicant respectfully asserts that the Examiner's interpretation is in error. The "plurality of sources" the Examiner cites (e.g., Census Bureau and CZECH Information Center) are not connected to the central control module in the manner defined in Applicant's present invention. Rather, these databases are separate and distinct from any available to the Family Tree House application and require the user to manually search, identify, record, and transfer any data from such a database back to Family Tree House application. Moreover, such databases only contain similar or identical information as to that which was inputted by the user in the Family Tree House application, and would not generate the value added family information contemplated in Applicant's present invention.

II. The cited reference combinations of Family Tree House website in view of Adler et al (U.S. 6,675,356) does not disclose or suggest a motivation to be combined to obtain Applicant's presently claimed invention.

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As is well settled, an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would *impel* one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993). The rejection fails to provide any reason why one would be motivated, let alone impelled, to combine the Family Tree House website and Adler references in the manner suggested by the Examiner. Thus, the rejection fails to set forth the required facts and reasoning required to support a *prima facie* case of obviousness. For this additional reason the rejection should be withdrawn.

The rejection also posits that one "would have been motivated to employ the process of Family Tree House in combination with the systems of either Adler, with the expectation of obtaining the desired product." (Office Action dated 06 April, 2005 at Page 4). The rejection, however, fails to provide any statutory prior art to support that conclusion. And, instead characterizes the only difference between the claims and the reference combination as mere "obvious modification." (*Id.*)

As detailed herein, the Family Tree House website reference discloses an on-line application that allows a registered user to input predefined and structured genealogical relationships (e.g., Spouse-Spouse or Parent-Child), and then display and/or disseminate via user inputted e-mail addresses that same limited, structured relationship graphically; the Adler et al reference discloses a system for managing, with user guidance and input, calendar information obtained from a variety of sources; and the Tuzhilin et al reference (6,236,978) discloses systems and methods for generating user profiles. Nowhere in the cited web site or other references provided by the Examiner can Applicant find any indication that the Family Tree House application could be modified and/or combined with any other application or technology to produce Applicant's present invention of a family information management system as is required to show a *prima facie* case of obviousness (MPEP 2142).

As is well settled, an Examiner's belief or conjecture is no substitute for statutory prior art. *In re Kratz*, 201 USPQ 71, 76 (CCPA 1979) citing, *In re Antonie*, 195 USPQ 6 (CCPA 1977). ("We have previously rejected the argument that undirected skill of one in the pertinent art is an adequate substitute for statutory prior art."). Because the rejection

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has substituted conjecture as to what one skilled in the art would believe for the required statutory reference, for this additional reason the rejection should be withdrawn.

In addition, the Examiner's argument that subject matter which may admittedly not be disclosed by the Family Tree House website or the Adler or Tuzhilin references, would still be obvious, also is contrary to the law. As is now well settled, obviousness *cannot* be based on the unknown. *In re Ochia*, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995).

A *prima facie* case of obviousness, however, requires that the rejection describe with specificity why one skilled in the art would have combined two references to arrive at the claimed invention. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (CAFC 1999). ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of *the requirement for a showing of the teaching or motivation to combine prior art references.*"). In the present case, no such explanation is found in the rejection.

Thus, the rejection is not supported by the kind of specificity required to sustain a conclusion of obviousness. *Ex parte Humphreys*, 24 USPQ 2d 1255, 1262 (BPAI 1992). ("The Examiner's rejection is not specific as to how one of ordinary skill in the art would have found it (the claimed invention) obvious"). For this reason alone, the rejection should be withdrawn.

Obviousness, however, cannot be based upon speculation. Nor can obviousness be based upon possibilities or probabilities. Obviousness *must* be based upon facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (CCPA 1970). When a conclusion of obviousness is not based upon facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993).

Moreover, whether or not the Family Tree House website and Adler are non-analogous arts, it remains that the question of "non-analogous art" is relevant to whether it would be proper to combine references. *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). That is, even when references are in related arts, the Examiner still has the burden of establishing (1) that there is suggestion or motivation to combine the references relied upon, and (2) that the references, when so combined, contain the requisite suggestion and motivation which would have led one to combine the particular disclosure relied upon and to make a composition as claimed. *In re Dembiczak*, 50 USPQ2d 1614,

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1617 (Fed. Cir. 1999). Here, the Examiner has not provided *any* reason for *why* one would have picked the specific system of Adler et al., to the exclusion of any other system.

The Examiner was required to demonstrate *where* in the Family Tree House website or Adler or Tuzhilin, there is a suggestion which would have “strongly motivated” one to make family management system as claimed. *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. App. 1986). The type of motivation which would have “*impelled*” one to do so (*Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993)), and the type of suggestion that the changes “*should*” be made. *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964).

Because the rejection has not identified *any* suggestion, reason, or other motivation, including suggestion of desirability, for *why* one would have been led to pick the genealogy website relied upon by the rejection, and include it in a family information management system as claimed, the rejection should be withdrawn.

Moreover, should the Examiner provide such a showing in accordance with MPEP § 2144.03 and 37 CFR 1.104(d)(2) as has been requested, the rejection over Family Tree House in view of Adler et al. would still be deficient because the Examiner’s “obvious to use” argument employs the wrong legal standard. *In re Antonie*, 195 USPQ 6, 8 (CCPA 1977). “Obvious to use” *disregards* the invention as a whole, and “obvious to use” does *not* release the Examiner from the burden of establishing *all* of the elements required to make out a *prima facie* case of obviousness for each claim.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC §103(a). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-37 is respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By 
Signature

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**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED
 COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: Changes To Implement Electronic Maintenance of Official Patent Application Records (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period. ***Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.***

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, must include a complete listing of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the text of each pending claim (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

(1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), (*previously presented*) and (*not entered*). The text of all pending claims, including withdrawn claims, must be submitted each time any claim is amended. Canceled and not entered claims must be indicated by only the claim number and status, without presenting the text of the claims.

(2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., ~~[[error]]~~); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., ~~[[4]]~~). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn— currently amended."

(3) The text of pending claims not being currently amended, including withdrawn claims, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims. 06/30/03 Flyer for mailing with all Office actions by all TCs

(4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.

(5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.

(6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 ((canceled))).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a green blue handle.

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Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for *deletion of five characters or fewer, double brackets may be used (e.g., [[error]])*; and (2) if *strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks)*, double brackets must be used (e.g., [[4]]). *As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)*

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, *and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations.* Any replacement drawing sheet must be identified in the top margin as

"Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *Any marked-up (annotated) copy showing changes must be labeled "Annotated Sheet Showing Changes" and accompany the replacement sheet as an appendix to the amendment.*

The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patent.practice@uspto.gov or by phone at (703)305-1616.

06/30/03 Flyer for mailing with all Office actions by all TCs

FAMILY INFORMATION MANAGEMENT SYSTEM

ABSTRACT OF THE DISCLOSURE

An integrated computer assisted integrated family information management system is described. The family information management system utilizes a central control module and a user interface. The central control model contains at least one family data file. The system further contains at least one information source connected to the central control module. Relevant family information is obtained from the information source and is processed with information stored in the family data file to create value-added family information. The value added information is accessible in the central control module through the user interface system.